

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: M. S. BRIGHT et al.	Conf. No. 8261
Appln. No.	: 09/303,368	Group Art unit: 3627
Filed	: April 30, 1999	Examiner: G. J. O'Connor
For	: PRE-PROCESS FOR INBOUND SALES ORDER REQUESTS WITH LINK TO A THIRD PARTY AVAILABLE TO PROMISE SYSTEM	

SUPPLEMENTAL APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief-Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

The instant Supplemental Appeal Brief is responsive to the Notice of Non-Compliant Appeal Brief mailed on June 19, 2006. Appellant has revised the Summary of the Claimed Subject matter (Section V) to refer the specification page and line numbers. Consistent with the Notice, the Grounds of Rejection (section VI) and the Related Proceedings Appendix has been changed.

This appeal is from the Examiner's final rejection of claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 as set forth in the Final Office Action of October 20, 2005. A Notice of Appeal and a Request For Pre-Appeal Brief Review, in response to the October 20, 2005 Final Office Action, was filed on January 20, 2006.

No additional fee is believed to be required for filing the instant Appeal Brief. However, if for any reason a necessary fee is required for consideration of the instant paper, authorization is hereby given to charge the fee for the Appeal Brief and any necessary extension of time fees to Deposit Account No. 09-0456.

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(I) REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation by an assignment recorded in the U.S. Patent and Trademark Office on April 30, 1999, at Reel 9937 and Frame 0007.

(II) RELATED APPEALS AND INTERFERENCES

No related appeals and/or interferences are pending. The instant appeal follows a prior appeal to the Board which was awarded Appeal No. 2003-0901 and which affirmed the Final Rejection dated February 5, 2002.

(III) STATUS OF THE CLAIMS

Claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 stand finally rejected. Claims 2, 5, 7, 10, 12 and 16-24 have been canceled. Claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 are pending and are part of this appeal. The claims in issue are attached in the "Claims Appendix".

(IV) STATUS OF THE AMENDMENTS

A response under 37 C.F.R. § 1.116 was filed December 20, 2005, requesting reconsideration of the finally rejected claims. The Examiner responded with an Advisory Action dated January 4, 2006, indicating that the request for reconsideration was considered, but did not place the application in condition for allowance. Appellant submits that no other amendments after final rejection have been filed and that all amendments to the claims have been entered.

(V) SUMMARY OF THE CLAIMED SUBJECT MATTER

A. The Claimed Subject Matter

1. INDEPENDENT CLAIM 1

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides for a system for pre-processing orders before they are transmitted to an order processing system (209), comprising: an order interceptor (201) receiving and pre-processing electronic sales order data (see page 10, line 11 to page 11, line 5 of the specification) prior to transmitting to the order processing system (209), the order interceptor (201) being capable of adding, changing and deleting electronic sales order data (see page 7, line 15 to page 8, line 1 of the specification), wherein changes to an electronic sales order are logged so as to provide an audit trail of activity (see page 7, line 15 to page 8, line 1 of the specification); an interface system (204 and/or 205) receiving the electronic sales order data from the order interceptor (201) and performing an availability check (see page 5, line 21 to page 6, line 8 and page 13, lines 1-15 of the specification), wherein the availability check (204) determines the portions of the electronic sales order data that can be satisfied (see page 13, lines 1-15 of the specification); and means for transmitting (208) at least a portion of the electronic sales order data to the order processing system (209) for order processing (see page 12, lines 5-14 of the specification).

2. INDEPENDENT CLAIM 31

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides for a system for pre-processing orders before they are transmitted to an order processing system (209), comprising: an order interceptor (201) receiving and pre-processing electronic sales order data (page 10, line 11 to page 11, line 5 of the specification) prior to transmitting to the order processing system (209), wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests (see page 5, line 21 to page 6, line 13 of the specification) prior to transmitting (see page 12, lines 5-14 of the specification) to the order processing system (209); an interface system (204 and/or 205) receiving the electronic sales order data from the order interceptor (201) and performing an availability check (see page 5, line 21 to page 6, line 8 and page 13, lines 1-15 of the specification), wherein the availability check determines the portions of the electronic sales order data that can be satisfied (see page 13, lines 1-15 of the specification; and means for transmitting (208) at least a portion of the electronic sales order data to the order processing system (209) for order processing (see page 12, lines 5-14 of the specification).

3. DEPENDENT CLAIM 3

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides that the order interceptor comprises: means for translating (205) the electronic sales order data to an internal format of the order interceptor (see page 10, line 11 to page 11, line 5 of the

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specification); means for determining (306) if an availability check is required (see page 13, lines 1-15 of the specification); means for transmitting (208) at least a portion of the electronic sales order data (see page 12, lines 5-14 of the specification); means for determining (206) if there are any processing problems associated with the electronic sales order data (see page 11, lines 6-15 of the specification); and means for processing (201 and 210) the electronic sales order data in accordance with business rules (see page 10, line 11 to page 11, line 5).

4. DEPENDENT CLAIM 6

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides that the workbench comprises: a) means for displaying (206 and/or a user terminal 403 in step 408) electronic sales order data that contains errors or is incomplete (see page 14, line 8 to page 15, line 14); b) means for displaying (415 and/or a user terminal 403 in step 408) error messages associated with the electronic sales order data of step a); and c) means (206) for correcting, editing, and updating the at least one database containing electronic sales order data (see page 14, line 8 to page 15, line 14).

5. DEPENDENT CLAIM 8

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides that the workbench further comprises: means for displaying (403) the status of the electronic sales order data; means for determining (411) if the configuration rules are satisfied;

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and means for indicating (412 and/or 207) to the order interceptor that at least a portion of the electronic order data is rejected (see page 14, line 8 to page 16, line 16).

6. DEPENDENT CLAIM 11

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides that the reject acknowledgment system (207) comprises: means for updating (513) the at least one database to indicate the portions of the electronic order data that have been rejected (see page 15, line 16 to page 16, line 16).

7. DEPENDENT CLAIM 13

With reference to page 10, line 11 to page 76, line 9 of the specification and to the figures, and by way of non-limiting example, the invention provides that the reject acknowledgment system (207) further comprises: means for determining (505) if the electronic sales order data was received via a transmission from the World Wide Web; and means for updating the at least one database in either an ESO format or an SAP format (see page 11, line 16 to page 12, line 4 and page 14, line 8 to page 15, line 14).

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,023,683 to JOHNSON et al. alone.

(VII) ARGUMENT RE. 103(a) REJECTION

REJECTION OF INDEPENDENT CLAIM 1 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over

JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Independent claim 1 recites a system for pre-processing orders before they are transmitted to an order processing system, comprising: an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, the order interceptor being capable of adding, changing and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity; an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

On pages 3 and 4 of the Final Office Action, the Examiner asserted that:

[JOHNSON] clearly anticipates all of the substantive elements of the instant invention, except that the system of [JOHNSON] is an integrated, unitary system, performing all necessary processing steps/functions, whereas the system contemplated by the instant invention, while performing exactly the same steps/functions overall, merely splits the various processing steps/functions out into two separate modules or processing systems, a "pre-processor" and a "processor".

Appellants respectfully disagree. First, JOHNSON does not disclose or suggest an order interceptor that receives and pre-processes electronic sales order data prior to transmitting to the order processing system such that the order interceptor is capable of adding, changing and deleting electronic sales order data, much less, that changes to

an electronic sales order are logged so as to provide an audit trail of activity. Indeed, the Examiner has failed to identify any language in JOHNSON whatsoever which even remotely discloses or suggests this feature.

The Examiner relies on certain arguments made in the Examiner's Answer in the prior appeal. This is improper because the prior appeal was not based on the combination of features presently recited in claim 1, and did not discuss how JOHNSON alone discloses or suggests this combination of features.

Appellants acknowledge that, on page 6 of the instant Final Office Action, the Examiner asserts that this feature is taught at col. 15, lines 60-62 of JOHNSON. However, this assertion is without merit.

The noted language of JOHNSON merely states the following:

Electronic sourcing system 5 also contains the capability to log messages returned from inventory sourcing program or programs 44B of Fisher RIMS system 40.

Such language is hardly suggestive of an order interceptor that receives and pre-processes electronic sales order data prior to transmitting to the order processing system such that the order interceptor is capable of adding, changing and deleting electronic sales order data, much less, that changes to an electronic sales order are logged so as to provide an audit trail of activity. Nor has the Examiner explained how such language is suggestive of this feature.

Second, Appellants submit that the system of JOHNSON relies extensively on human manual interaction to search catalog databases and to *subsequently build an*

order. As a result, JOHNSON does not teach intercepting or receiving a "completed" order submission and checking for portions of the sales order that can be satisfied as recited by claim 1.

Third, Appellants do not dispute that JOHNSON is capable of creating an order list including desired catalog items available from vendor product catalogs as a result of such a database search. To provide these functions, JOHNSON shows a computer that maintains a catalog database including product information relating to catalog items available from vendor product catalogs, and a means for generating a requisition including at least one requisitioned item. Information at least partially identifying an item desired to be requisitioned is entered *manually by a user*, and utilized for searching the database for catalog items matching that information and for selecting at least one item as a result of the search. Data identifying the selected catalog items are communicated to the requisition building module, which generates a requisition including entries for items corresponding to the selected catalog items. Additionally, JOHNSON may check the availability of one or more inventory locations of the corresponding catalog items (See, cols. 2 and 3). However, these features are not suggestive or the features recited in at least claim 1, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 1.

REJECTION OF INDEPENDENT CLAIM 31 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 31 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Independent claim 31 recites a system for pre-processing orders before they are transmitted to an order processing system, comprising: an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system; an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

On page 4 of the Final Office Action, the Examiner acknowledged that JOHNSON does "not specifically teach splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system." However, the Examiner explains that this feature "is certainly well known, hence obvious, ..." Appellants respectfully disagree.

First, the Examiner is not correct that because a feature is asserted to be known that it is automatically or *per se* obvious. If this were true, nothing would be patentable because virtually all inventions are directed to a combination of known features.

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Second, the Examiner has not established that this feature is in fact “well known”. Appellants remind the Examiner that MPEP 2144.03 specifically explains that “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” Accordingly, Appellants respectfully request that the Examiner produce documentary evidence to support the Examiner’s assertions to the extent that the Examiner is relying on official notice.

Third, Appellants do not dispute that JOHNSON is capable of creating an order list including desired catalog items available from vendor product catalogs as a result of such a database search. To provide these functions, JOHNSON shows a computer that maintains a catalog database including product information relating to catalog items available from vendor product catalogs, and a means for generating a requisition including at least one requisitioned item. Information at least partially identifying an item desired to be requisitioned is entered *manually by a user*, and utilized for searching the database for catalog items matching that information and for selecting at least one item as a result of the search. Data identifying the selected catalog items are communicated to the requisition building module, which generates a requisition including entries for items corresponding to the selected catalog items. Additionally, JOHNSON may check the availability of one or more inventory locations of the corresponding catalog items (See, cols. 2 and 3). However, these features are not suggestive or the features recited in at least claim 31, and the Examiner has not demonstrated otherwise.

Because the above-noted document fails to disclose, or even suggest, at least

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the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 31.

REJECTION OF DEPENDENT CLAIM 3 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 3 recites that the order interceptor comprises: means for translating the electronic sales order data to an internal format of the order interceptor; means for determining if an availability check is required; means for transmitting at least a portion of the electronic sales order data; means for determining if there are any processing problems associated with the electronic sales order data; and means for processing the electronic sales order data in accordance with business rules.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 3. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 3. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests an order interceptor that comprises: means for translating the electronic sales order data to an internal format of the order interceptor; means for determining if an availability check is required; means for transmitting at least a portion of the electronic sales order data; means for determining if there are any processing problems associated with the

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electronic sales order data; and means for processing the electronic sales order data in accordance with business rules. Finally, Appellants also submit that dependent claim 3 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 3.

REJECTION OF DEPENDENT CLAIM 6 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 6 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 6 recites that the workbench comprises: a) means for displaying electronic sales order data that contains errors or is incomplete; b) means for displaying error messages associated with the electronic sales order data of step a); and c) means for correcting, editing, and updating the at least one database containing electronic sales order data.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 6. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 6. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests a workbench that comprises: a) means for displaying electronic sales order data that contains errors or is

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incomplete; b) means for displaying error messages associated with the electronic sales order data of step a); and c) means for correcting, editing, and updating the at least one database containing electronic sales order data. Finally, Appellants also submit that dependent claim 6 is allowable at least for the reason that this claim depends from allowable claims 1 and 4.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 6.

REJECTION OF DEPENDENT CLAIM 8 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 8 recites that the workbench further comprises: means for displaying the status of the electronic sales order data; means for determining if the configuration rules are satisfied; and means for indicating to the order interceptor that at least a portion of the electronic order data is rejected.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 8. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 8. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the workbench

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further comprises: means for displaying the status of the electronic sales order data; means for determining if the configuration rules are satisfied; and means for indicating to the order interceptor that at least a portion of the electronic order data is rejected. Finally, Appellants also submit that dependent claim 8 is allowable at least for the reason that this claim depends from allowable claims 1, 4 and 6.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 8.

REJECTION OF DEPENDENT CLAIM 9 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 9 recites that the system further comprises a reject acknowledgment system receiving an indication from the order interceptor that at least a portion of the electronic sales order data has been rejected.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 9. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 9. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests a reject acknowledgment system receiving an indication from the order interceptor that at least

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a portion of the electronic sales order data has been rejected. Finally, Appellants also submit that dependent claim 9 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 9.

REJECTION OF DEPENDENT CLAIM 11 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 11 recites that the reject acknowledgment system comprises means for updating the at least one database to indicate the portions of the electronic order data that have been rejected.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 11. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 11. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the reject acknowledgment system comprises means for updating the at least one database to indicate the portions of the electronic order data that have been rejected. Finally,

Appellants also submit that dependent claim 11 is allowable at least for the reason that this claim depends from allowable claims 1 and 9.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 11.

REJECTION OF DEPENDENT CLAIM 13 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 13 recites that the reject acknowledgment system further comprises: means for determining if the electronic sales order data was received via a transmission from the World Wide Web; and means for updating the at least one database in either an ESO format or an SAP format.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 13. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 13. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the reject acknowledgment system further comprises: means for determining if the electronic sales order data was received via a transmission from the World Wide Web; and means for updating the at least one database in either an ESO format or an SAP

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format. Finally, Appellants also submit that dependent claim 11 is allowable at least for the reason that this claim depends from allowable claims 1, 9 and 11.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 13.

REJECTION OF DEPENDENT CLAIM 14 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 14 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 14 recites that the order interceptor receives the electronic sales order data in a standard Electronic Data Interchange (EDI) format.

The Examiner has failed to identify any disclosure in JOHNSON with regard to each of the features recited in claim 14. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 14. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor receives the electronic sales order data in a standard Electronic Data Interchange (EDI) format. Finally, Appellants also submit that dependent claim 14 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper

modification of this document renders unpatentable the combination of features recited in at least independent claim 14.

REJECTION OF DEPENDENT CLAIM 15 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 15 recites that the system is a SAP system.

The Examiner has failed to identify any disclosure in JOHNSON with regard to the recited SAP system of claim 15. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 15. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the system is an SAP system. Finally, Appellants also submit that dependent claim 15 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 15.

REJECTION OF DEPENDENT CLAIM 25 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 25 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 25 recites that the order interceptor determines if any processing problems are present and, if so, creates a workflow item that can be reviewed and modified prior to transmitting to the order processing system.

The Examiner has failed to identify any disclosure in JOHNSON with regard to the features recited in claim 25. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 25. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor determines if any processing problems are present and, if so, creates a workflow item that can be reviewed and modified prior to transmitting to the order processing system. Finally, Appellants also submit that dependent claim 25 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 25.

REJECTION OF DEPENDENT CLAIM 26 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 26 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 26 recites that the order interceptor validates an accuracy of the electronic sales order at the different stages prior to transmitting to the order processing system.

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The Examiner has failed to identify any disclosure in JOHNSON with regard to the features recited in claim 26. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 26. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor validates an accuracy of the electronic sales order at the different stages prior to transmitting to the order processing system. Finally, Appellants also submit that dependent claim 26 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 26.

REJECTION OF DEPENDENT CLAIM 27 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 27 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 27 recites that the order interceptor processes data by customer specific business rules prior to transmitting to the order processing system.

The Examiner has failed to identify any disclosure in JOHNSON with regard to the features recited in claim 27. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 27. Furthermore, while it may be argued that

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JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor processes data by customer specific business rules prior to transmitting to the order processing system. Finally, Appellants also submit that dependent claim 27 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 27.

REJECTION OF DEPENDENT CLAIM 28 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 28 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 28 recites that the order interceptor ensures all attributes are present and accurate in the electronic sales order prior to transmitting to the order processing system.

The Examiner has failed to identify any disclosure in JOHNSON with regard to the features recited in claim 28. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 28. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor ensures all attributes are present and accurate in the electronic sales order

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prior to transmitting to the order processing system. Finally, Appellants also submit that dependent claim 28 is allowable at least for the reason that this claim depends from allowable claims 1 and 27.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 28.

REJECTION OF DEPENDENT CLAIM 29 UNDER 35 U.S.C. § 103 IS IN ERROR

The rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over JOHNSON alone is in error, the decision of the Examiner to reject this claim should be reversed, and the application should be remanded to the Examiner.

Claim 29 recites that the order interceptor allows correction of problems in the electronic sales order in a prior to transmitting to the order processing system.

The Examiner has failed to identify any disclosure in JOHNSON with regard to the features recited in claim 29. As such, a *prima facie* case of unpatentability has not been set forth with regard to claim 29. Furthermore, while it may be argued that JOHNSON discloses a requisition/purchasing system that uses various devices and programs, it is not apparent that JOHNSON discloses or suggests that the order interceptor allows correction of problems in the electronic sales order in a prior to transmitting to the order processing system. Finally, Appellants also submit that dependent claim 29 is allowable at least for the reason that this claim depends from allowable claim 1.

Because the above-noted document fails to disclose, or even suggest, at least the above-noted features of the instant invention, Appellants submit that no proper modification of this document renders unpatentable the combination of features recited in at least independent claim 29.

(VIII) CONCLUSION

Each of claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 are patentable under 35 U.S.C. § 103(a). Specifically, the applied art of record fails to disclose or suggest the unique combination of features recited in Appellants' claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31. Accordingly, Appellants respectfully request that the Board reverse the decision of the Examiner to finally reject claims 1, 3, 4, 6, 8, 9, 11, 13-15 and 25-31 under 35 U.S.C. § 103(a), and remand the application to the Examiner for withdrawal of the above-noted rejections.

Respectfully submitted,
M. S. BRIGHT et al.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', written over a horizontal dashed line.

Andrew M. Calderon
Reg. No. 38,093

July 18, 2006
GREENBLUM & BERNSTEIN, P.L.C.
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Attachments: Claims Appendix, Evidence Appendix, and Related Proceedings Appendix

CLAIMS ON APPEAL

1. A system for pre-processing orders before they are transmitted to an order processing system, comprising:

an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, the order interceptor being capable of adding, changing and deleting electronic sales order data, wherein changes to an electronic sales order are logged so as to provide an audit trail of activity;

an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

3. The system of claim 1, wherein the order interceptor comprises:

means for translating the electronic sales order data to an internal format of the order interceptor;

means for determining if an availability check is required;

means for transmitting at least a portion of the electronic sales order data;

means for determining if there are any processing problems associated with the electronic sales order data; and

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means for processing the electronic sales order data in accordance with business rules.

4. The system of claim 1, further comprising a workbench receiving electronic sales order data that contains errors or is incomplete.

6. The system of claim 4, wherein the workbench comprises:

a) means for displaying electronic sales order data that contains errors or is incomplete;

b) means for displaying error messages associated with the electronic sales order data of step a); and

c) means for correcting, editing, and updating the at least one database containing electronic sales order data.

8. The system of claim 6, wherein the workbench further comprises:

means for displaying the status of the electronic sales order data;

means for determining if the configuration rules are satisfied; and

means for indicating to the order interceptor that at least a portion of the electronic order data is rejected.

9. The system of claim 1, further comprising a reject acknowledgment system receiving an indication from the order interceptor that at least a portion of the electronic sales order data has been rejected.

11. The system of claim 9, wherein the reject acknowledgment system comprises:

means for updating the at least one database to indicate the portions of the electronic order data that have been rejected.

13. The system of claim 11, wherein the reject acknowledgment system further comprises:

means for determining if the electronic sales order data was received via a transmission from the World Wide Web; and

means for updating the at least one database in either an ESO format or an SAP format.

14. The system of claim 1, wherein the order interceptor receives the electronic sales order data in a standard Electronic Data Interchange (EDI) format.

15. The order interceptor system of claim 1, wherein the system is an SAP system.

25. The order interceptor system of claim 1, wherein the order interceptor determines if any processing problems are present and, if so, creates a workflow item that can be reviewed and modified prior to transmitting to the order processing system.

26. The order interceptor system of claim 1, wherein the order interceptor validates an accuracy of the electronic sales order at the different stages prior to transmitting to the order processing system.

27. The order interceptor system of claim 1, wherein the order interceptor processes data by customer specific business rules prior to transmitting to the order processing system.

28. The order interceptor system of claim 27, wherein the order interceptor ensures all attributes are present and accurate in the electronic sales order prior to transmitting to the order processing system.

29. The order interceptor system of claim 1, wherein the order interceptor allows correction of problems in the electronic sales order in a prior to transmitting to the order processing system.

30. The order interceptor system of claim 1, wherein the electronic sales order data is a proposed customer order.

31. A system for pre-processing orders before they are transmitted to an order processing system, comprising:

an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system, wherein pre-processing the electronic sales order includes splitting the electronic sales order into at least two separate requests prior to transmitting to the order processing system;

an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 35 U.S.C. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 35 U.S.C. §41.37(c)(ix).

NO.	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
1	N/A	N/A

RELATED PROCEEDINGS APPENDIX

Pursuant to 35 U.S.C. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 35 U.S.C. §41.37(c)(1)(ii) are enclosed herewith.

NO.	TYPE OF PROCEEDING	REFERENCE NO.	DATE
1	Decision of the Board	Appeal No. 2003-0901	August 6, 2004

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 37

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARION SCOTT BRIGHT, PUSHPALATHA CHANNIKERE,
BALASUBRAMANIAN GOPALAN, RAHUL JINDANI, JINRAJ DHURUVAKUMAR
JOSHIPURA, VINOD KANNOTH, JAYAKUMAR KRISHNAMURTHY, GREGORY LEE
MCKEE, SYLVAIN MICHEL, PENNY JEANNETTE PEACHEY-KOUNTZ
and JAMES DONALD SCOTT

Appeal No. 2003-0901
Application 09/303,368

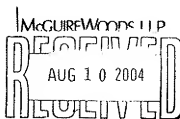
HEARD: JULY 14, 2004

Before HAIRSTON, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1, 3, 4, 6, 8, 9, 11 and 13-24, which constitute all the claims remaining in the application.



The disclosed invention pertains to a method and apparatus for pre-processing electronic sales order data before it is transmitted to an order processing system.

Representative claim 1 is reproduced as follows:

1. A system for pre-processing orders before they are transmitted to an order processing system, comprising:

an order interceptor receiving and pre-processing electronic sales order data prior to transmitting to the order processing system;

an interface system receiving the electronic sales order data from the order interceptor and performing an availability check, wherein the availability check determines the portions of the electronic sales order data that can be satisfied; and

means for transmitting at least a portion of the electronic sales order data to the order processing system for order processing.

The examiner relies on the following references:

Johnson et al. (Johnson)	6,023,683	Feb. 08, 2000 (filed Aug. 10, 1994)
Blinn et al. (Blinn)	6,058,373	May 02, 2000 (filed Oct. 16, 1996)

Claims 1, 3, 4, 6, 8, 9, 11 and 13-24 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Blinn taken alone or Johnson taken alone.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we affirm.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to

modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this

decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 1.192(a)].

We consider first the rejection of all pending claims based on the teachings of Blinn. The examiner finds that Blinn teaches the claimed invention except that Blinn does not teach two separate processing systems, that is, a pre-processing system and a processing system. The examiner finds that it would have been obvious to the artisan to modify the integrated Blinn system so as to split the processing disclosed therein into two separate processing systems as claimed [answer, pages 4-5].

Appellants argue that their invention relates to an integrated system for pre-processing Electronic Sales Orders (ESOs) or Electronic Purchase Orders (EPOs) in order to validate certain criteria before routing the same, altered, or additional ESOs or EPOs to an order processing system. Appellants assert that the claimed pre-processing is meant to act upon an entire order before the actual subsequent order placement. Appellants note that their invention amounts to much more than splitting the processing into pre-processing and processing. Appellants argue that Blinn has no disclosure of pre-processing orders as defined in the present invention. Appellants note that the claimed pre-

processing occurs prior to any ESO being routed by a router to an order processing system [brief, pages 5-8].

With respect to independent claim 1, the examiner points out in detail how he reads the claimed invention on Blinn. The examiner notes that Blinn essentially anticipates the claimed invention except for the fact that the examiner has interpreted the claimed invention as requiring separate systems for the pre-processing and for the processing. The examiner finds that Blinn teaches all the functions of the claimed invention except that the pre-processing and processing of Blinn are integrated into a single device. The examiner responds that the pre-processing steps of Blinn are performed before the processing steps and before any actual order placement [answer, pages 6-10].

Appellants respond that the present invention is meant for intercepting an already completed purchase order between two trading partners and then pre-processing the completed purchase order before re-submitting the order to an appropriate order fulfillment system. Appellants argue that Blinn does not perform what is termed pre-processing by the present invention. Appellants argue that the "pre-processing" in Blinn occurs before the purchase order is completed so that it is not pre-processing as intended by the claimed invention [reply brief, pages 4-7].

We will sustain the examiner's rejection of independent claim 1 based on the teachings of Blinn. The thrust of appellants' arguments is that the "pre-processing" of the claimed invention refers to pre-processing of completed purchase orders which is different than the pre-processing of Blinn identified by the examiner. We do not agree with appellants' arguments. During prosecution before the examiner, claims are given their broadest reasonable interpretation. This is done because an applicant has an opportunity at this time to amend the claims so that they accurately reflect what the applicant is trying to protect. The examiner has read the pre-processing of claim 1 on the processing in Blinn which takes place before the final processing of the order is confirmed. We agree with the examiner that these operations of Blinn, such as item availability, can be considered to fall within the broad term of pre-processing in claim 1. We also agree with the examiner that it would have been obvious to the artisan to separate the pre-processing operations and the processing operations of Blinn into separate processing devices as explained by the examiner. We note, however, that we do not agree with the examiner's position that the claimed pre-processing and processing must be interpreted to include separate devices for performing the pre-processing and the processing. We

do not find any basis which compels reading two devices into the invention of claim 1.

Appellants indicate that the claims stand or fall together as a single group [brief, page 5]. Nevertheless, appellants refer to the limitations of several other claims on page 8 of the brief. Since this portion of the brief does nothing more than recite the limitations of other claims on appeal and make a general assertion that Blinn does not teach or suggest these limitations, we find that this portion of the brief does not constitute a valid separate argument for patentability. Therefore, all the other claims on appeal fall with claim 1 for reasons discussed above.

We now consider the rejection of all pending claims based on the teachings of Johnson. The examiner finds that Johnson teaches the claimed invention except that Johnson does not teach two separate processing systems, that is, a pre-processing system and a processing system. The examiner finds that it would have been obvious to the artisan to modify the integrated Johnson system so as to split the processing disclosed therein into two separate processing systems as claimed [answer, page 5].

Appellants' arguments with respect to this rejection essentially parallel the arguments discussed above with respect to the rejection based on Blinn. The examiner's response to appellants' arguments and appellants' arguments set forth in the reply brief are essentially the same as the arguments we considered above.

We will sustain the examiner's rejection of claim 1 based on the teachings of Johnson for reasons discussed above. Specifically, the key question again is appellants' improper attempt to have the term "pre-processing" of claim 1 interpreted in a manner which is narrower than its broadest reasonable interpretation. We agree with the examiner that the processing of Johnson which he has identified as pre-processing is consistent with the broadest reasonable interpretation of that term.

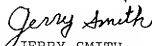
Once again, although appellants refer to other claims on appeal, the discussion of these other claims does not amount to a separate argument for patentability. Therefore, we also sustain the examiner's rejection of all the other claims on appeal based on Johnson.

In summary, we have sustained each of the examiner's rejections of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1, 3, 4, 6, 8, 9, 11 and 13-24 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


KENNETH W. HAIRSTON
Administrative Patent Judge)
)
)


JERRY SMITH
Administrative Patent Judge)
)
)


MICHAEL R. FLEMING
Administrative Patent Judge)
)
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BOARD OF PATENT
APPEALS AND
INTERFERENCES

JS/ki

Appeal No. 2003-0901
Application 09/303,368

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